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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,121	03/26/2004	Kevin D. Burrow	7432-0054	9223

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E. Victor Indiano
Suite 850
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Indianapolis, IN 46204

EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,121

Applicant(s)

BURROW ET AL.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/6/04; 7/9/04; 11/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the length of the inspiratory greater than the length of the expiratory tube must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Throughout the disclosure there is inconsistency what reference elements are being labeled, a few examples are: Page 21 [0082] "...expiratory port 47..." which was previously labeled as 48. "...casing 38..." then labeled "...connector 38..."; [0086] "...inspiratory tube connector 58..." then "...inspiratory tube connector 56..."; [0087] "...expiratory flow path 66..." then "...inspiratory flow path 70...".

Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Clawson et.al. (WO 85/05277).

Clawson in a unilimb breathing circuit discloses a proximal end coupling member (Fig. 4), a distal end coupling member (Fig. 4), a corrugated expiratory tube (110) having a first end coupled to the proximal end coupling member, and a second end coupled to the distal end coupling member, the expiratory tube being expandable between a fully compressed rest position and a fully expanded rest position, and having a plurality of intermediate rest positions wherein the expiratory tube is capable of

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maintaining its rest length without the exertion of an external force (Page 5), and an inspiratory tube (108) having a first end coupled to the proximal coupling member (Fig. 4), and a second end coupled to the distal end coupling member (Fig. 4), the inspiratory tube being expandable between a fully compressed position and a fully expanded position, and having a plurality of intermediate rest positions wherein the inspiratory tube is capable of maintaining its rest length without the exertion of an external force (Page 5), wherein the length of the inspiratory tube is greater than the length of the expiratory tube (based on how the inspiratory is expanded it is greater in length than the expiratory tube; Fig. 4).

With respect to claim 5, Clawson discloses a unilimb breathing circuit comprising: a proximal end coupling member (Fig. 4), a distal end coupling member (Fig. 4), a corrugated expiratory tube (110) having a first end coupled to the proximal end coupling member (Fig. 4), a second end coupled to the distal end coupling member (Fig. 4), an inner diameter and an outer diameter, the expiratory tube being expandable between a fully compressed rest position and a fully expanded rest position (Page 5), and having a plurality of intermediate rest positions wherein the expiratory tube is capable of maintaining its rest length without the exertion of an external force (based on the corrugated tubing, Page 5), and an inspiratory tube (108) having a first end coupled to the proximal end coupling member (Fig. 4), a second end coupled to the distal end coupling member (Fig. 4), an inner diameter and an outer diameter (Fig. 4), the inspiratory tube being expandable between a fully compressed position and a fully expanded position (based on the corrugated tubing, Page 5), and having a plurality of

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intermediate rest positions wherein the inspiratory tube is capable of maintaining its rest length without the exertion of an external force (based on the corrugated tubing, Page 5), wherein the ratio of the outer diameter of the inspiratory tube to the inner diameter of the expiratory tube is sized to minimize flow resistance there between, while facilitating generally linear compressibility and expandability of the inspiratory and expiratory tube (Fig. 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 3, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clawson et.al. (WO 85/05277).

The difference between Clawson and claim 2 is the length of the inspiratory tube being between about 1 and 7 inches when each of the inspiratory and expiratory tubes are in there fully expanded positions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the length of the inspiratory tube between about 1 and 7 inches, since it has been held where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With respect to claims 3 and 6-10, note rejection of claim 2 above.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clawson et.al. (WO 85/05277) in view of Nowacki et.al. (4,621,634).

The difference between Clawson and claim 4 is the distal end coupling member having axis of the terminus being radially offset from the axis of the distal end coupling member. Nowacki in a connector discloses a connector with an axis of the terminus being radially offset from the axis of the distal end coupling providing a crank effect

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facilitating assembly of the tapered exhaust fitting, thereby assuring a tighter connection (Abstract; Col. 1, lines 50-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the coupling of Clawson with any well known coupling with a axis of a terminus being radially offset doing so would have provided a coupling with a crank effect facilitating assembly of the tapered exhaust fitting, thereby assuring a tighter connection including the coupling taught by Nowacki.

Conclusion

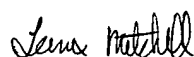
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show unilimb breathing circuits: 6,874,500; 2003/0188746; 6,536,428; 4,852,564.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell
Examiner
Art Unit 3743
June 24, 2005